UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,538	05/30/2001	James K. Prueitt	**BA-0330	1320

23377 7590 02/19/2009

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
AVELLINO, JOSEPH E	

ART UNIT	PAPER NUMBER
2446	

MAIL DATE	DELIVERY MODE
02/19/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES K. PRUEITT, RICHARD A. PINEAU,
KEVIN F. BERNIER, TODD M. LYNTON, and
SCOTT D. WICKER

Appeal 2008-2385
Application 09/870,538
Technology Center 2400

Decided:[1] February 19, 2009

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

---

[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

A Patent Examiner rejected claims 1-5, 7-9, 11-15, 17-20, 22-28, and 30. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

I. STATEMENT OF THE CASE[2]

A. INVENTION

The invention at issue on appeal relates to the opportunity to obtain a permanent record of the service rendered at the mobile device should be available regardless of mode of operation. To achieve the object of this invention for services originating at the mobile device and not related to the location of the device, one aspect of the invention includes a method for providing a service at a mobile device and generating, at the location of the mobile device, a permanent record of the service, the service and the permanent record being processed by at least one of many remote servers. The method comprises the steps of (a) receiving at a receiving center, from the mobile device, a request for the service, (b) providing, from the receiving center, data for the request to a service server, the service server being one of the at least one of many remote servers, (c) processing the request for service at the service server, the processing generating the data for the

[2] Procedurally, we note that two IDS statements have been filed after the Reply Brief was filed and the Examiner has not considered either of them prior to our decision on the merits. The Examiner should consider these IDS statements.

service, (d) providing the data for the service to a printing server, the printing server being one of the at least one of many remote servers, (e) processing, at the printing server, the data and other stored data to generate input data for a specific printer, and (f) transmitting to the mobile device the input data, the input being rendered by the specific printer at the location of the mobile device as the permanent record of the service. (Spec. 4-5.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method of providing a service at a mobile device and generating, at the location of said mobile device, a permanent record of said service, said service and said permanent record being processed by at least one of a plurality of remote servers, said method comprising the steps of:

> (A) receiving at a receiving center, from the mobile device, a request for the service and information identifying a specific printer on which service related data is to be printed at the location of the mobile device;
>
> (B) providing, from the receiving center, data for the request to a service server, said service server being one of said at least one of a plurality of remote servers;
>
> (C) processing the request for service at the service server, said processing generating the data for the service;
>
> (D) providing said data for the service to a printing server, said printing server being one of said at least one of a plurality of remote servers and including stored print data for optimizing the quality of prints printed on various specific printers;
>
> (E) processing, at the printing server, said service data and stored print data for the identified specific printer to generate input data for the specific printer in a manner to produce the optimal quality print for the specific printer;
>
> (F) transmitting to said mobile device said input data,

said input being rendered by the specific printer at the location of said mobile device as the permanent record of said service.

C. REFERENCES

The Examiner relies on the following references as evidence:

Cottrell	US 5,694,484	Dec. 2, 1997
Klear	WO 01/03040	Jan. 11, 2001
Ishizuka	US 2002/0065873 A1	May 30, 2002 (filed Nov. 30, 2000)
Devarics	US 6,553,240 B1	Apr. 22, 2003 (filed Dec. 30, 1999)
Fidler	US 6,725,051 B1	Apr. 20, 2004 (filed Apr. 30, 2001)

D. REJECTIONS

The Examiner makes the following rejections.

Claims 1-3, 5, 7, 9, 11, 12, 17-20, 22-24, and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klear in view of Devarics and further in view of Ishizuka.

Claims 4, 8, 13-15, and 25-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klear in view of Devarics in view of Ishizuka as stated in the claims above, and further in view of Fidler.

Claims 1-3, 5, 7, 9, 11, 12, 17-20, 22-24, and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klear in view of Devarics and further in view of Cottrell.

Claims 4, 8, 13-15, and 25-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klear in view of Devarics in view of Cottrell as stated in the claims above, and further in view of Fidler.

II. ISSUE

Have Appellants shown error in the Examiner's initial showing of obviousness and specifically whether it is appropriate to interpret Appellants' claimed invention in light of the three references incorporated by reference in the Specification concerning "optimal quality print."

III. PRINCIPLES OF LAW

35 U.S.C. § 103(a)

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR,* 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the

consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1740-41).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

IV. ANALYSIS

From our review of the Examiner's initial showing of obviousness, at pages 4-15 of the Answer, we find that the Examiner has set forth a sufficient initial showing of obviousness. Therefore, we look to Appellants' Briefs to show error in the Examiner's initial showing or the Examiner's line of reasoning.

Additionally, we note that the Examiner at pages 2-3 of the Answer identifies that the Appellants' Brief is deficient with respect to the means-plus-function limitations. Appellants attempt to remedy the deficiency by filing the Reply Brief which identifies corresponding structure, acts, or materials for independent claim 18, but Appellants do not address any of the dependent claims which contain means-plus-function limitations and are argued by Appellants. (For example, dependent claim 4 which contains a

means-plus-function limitation which is separately argued by Appellants.) Rather than remand the appeal, we will address Appellants' arguments with respect to dependent claim 4 to the extent that we find any corresponding structure, acts, or materials for the corresponding means limitation.

With respect to claim interpretation from Appellants' Summary of the Claimed Invention, we note that Appellants' Summary of the Claimed Invention for independent claim 1 merely identifies pages 4, 5, 9, and 10 of Appellants' Specification, but The Summary of the Claimed Invention for independent claim 18 additionally identifies that the means for processing to produce optimal quality print for the specific printer is disclosed in detail as techniques at page 11, lines 11 to 24 of the Specification. In the Specification, Appellants incorporate by reference the teachings of three different references to teach the processing to produce optimal quality print for the specific printer, but Appellants do not specifically discuss what is taught by each reference. (Reply Br. 12 and App. Br. 8). Additionally, we note that one of the references incorporated by reference is the Cottrell reference which the Examiner has applied against all the claims in the third and fourth stated rejections.

In view of the Examiner's reliance upon the same reference incorporated by reference in the Specification, it would appear that a rejection using the same reference as Appellants rely upon for support should clearly teach and fairly suggest that portion of the claimed invention. Additionally, the Examiner may desire to clarify with Appellants as to the corresponding, structure, or acts for the means for processing since the corresponding Specification sets forth only generalized discussions of the detailed techniques which are incorporated by reference.

Here, the Specification provides no guidance as to the specific interpretation for those techniques. Since Appellants have not specifically argued the details of independent claim 18 and have elected to group independent claim 18 and most of its dependent claims with independent claim 1, we need not address this matter. With this as background, we will address Appellants' arguments in the Briefs with respect to representative claim 1 and those dependent claims which are specifically argued.

With respect to independent claim 1, Appellants' main contention is that the Office has not established that the invention is prima facie obvious since the Office has not established the required elements (2)-(5) of a proper prima facie obviousness rejection. (App. Br. 8).

Appellants maintain that Klear, Devarics, and Ishizuka do not disclose or suggest that the print data be processed in a manner to produce the optimal quality print for the specific printer as required by independent claim 1 and wherein information identifying a specific local printer is sent to the remote servers at the service provider via the mobile device; a remote printing server has stored print data for optimizing the quality of print printed on a specific printer, and printing server processes service data and stored print data for the identified specific printer in a manner to produce the optimal quality print for the specific printer. (App. Br. 9-12).

Additionally, Appellants contend that since Devarics performs print data processing locally in the limited resource cell phone, it is clear that the phone does not have the capacity to do that type of print optimization process required by Appellants' claimed method and system. (App. Br. 11). Additionally, Appellants contend that Devarics does not disclose, teach or suggest the concept of doing computer intensive print optimization

processing on high-capacity remote servers operated by the service provider. (App. Br. 11). Here, we find no express support in the language of independent claim 1 for Appellants' asserted "computer intensive print optimization processing." Therefore, Appellants' arguments thereto are not persuasive of error in the Examiner's initial showing of obviousness.

Finally, Appellants argue that the teachings of Ishizuka concerning printer drivers, which allows for print data to be formatted appropriately for the type and size of printing on specific printers, is in error since Ishizuka does not disclose, teach, or suggest producing "optimal quality print for the specific printer" within the meaning of that language, as used in the present claims. (App. Br. 12). Appellants opine that "optimal quality print" means more than mere formatting as argued by the Office and that the three patents disclosed at page 11of the Specification describes in detail techniques for producing an image of optimal quality at a specific printer. Appellants further contend that producing such optimal quality prints, as recited in the claims, involves image processing and not merely formatting print data for a specific printer, as is accomplished by a printer driver. (App. Br. 12). Appellants further argue the combination of teachings is insufficient to teach or suggest this "critical element" of producing optimal quality prints as claimed and furthermore that the Examiner has relied upon impermissible hindsight reconstruction. (App. Br. 13).

Here, we disagree with Appellants contentions and find that the Examiner has set forth a proper showing in the rejection and provided a reasoned statement for the combination of the teachings as to why it would have been obvious to one of ordinary skill in the art to combine the teachings in the manner advanced by the Examiner. Appellants' generalized

argument that the Examiner has relied upon hindsight reconstruction without further explanation is not persuasive of the error in the Examiner's initial showing of obviousness. Furthermore, the Examiner has shown how each of the prior art teachings in combination teaches and fairly suggests the claimed invention to optimize the print data for a specific printer wherein the Examiner finds that a printer driver produces an optimal quality print.

Appellants rely upon the techniques incorporated by reference in the Specification at page 11 to interpret how "optimal print quality" should be interpreted. Appellants, at page 13 of the Reply Brief, admit that the phrase by "optimal quality print" is not explicitly defined in the Specification, but Appellants contend that the phrase would be construed by an ordinarily skilled artisan to involve image processing and would be interpreted by an ordinarily skilled artisan to be more than mere formatting as the Examiner has maintained.

At page 14 of the Reply Brief, Appellants' rely upon the teachings of column 3 of the Cottrell reference teaches that image quality is principally defined by four image parameters. Cottrell additionally teaches that image quality may also be subjective to in nature. (Cottrell col. 3, l. 41). Therefore, since image quality may be deemed to be subjective, we find that the Examiner's reliance upon the printer driver formatting to be one of the most basic image quality factors to be considered by those skilled in the art without which any other subjective or objective image processing would be useless to improve the image quality.

Here, Appellants strain to interpret indirectly "optimal quality prints." Furthermore, Appellants' mere assertion, that the prior art techniques as disclosed in the three patents which are incorporated by reference into the

Specification, does not specifically differentiate the "optimal quality print" from the printer driver formatting of Ishizuka.

Appellants further assert at page 15 of the Reply Brief that *KSR* reiterates the five elements for a proper prima facie rejection of obviousness and Appellants submit that all of the above five elements have not been established and that the rejection is improper. We find Appellants' assertion to be based on the asserted deficiency in the Examiner's reliance upon the printer driver rather than optimal quality prints as determined by the techniques disclosed at page 11 of the Specification. Therefore, Appellants' argument is not persuasive of error in the Examiner's initial showing of obviousness, as discussed above.

In the Reply Brief, Appellants reiterate those arguments set forth in the Brief and contend that the combined teachings of the three references relied upon by the Examiner do not teach and fairly suggest the claimed "optimal print quality." (Reply Br. 11-20). Again, we do not find these arguments persuasive of error in the Examiner's initial showing of obviousness nor in the Examiner's line of reasoning for the combination of teachings. Therefore, Appellants have not shown error in the Examiner's initial showing of obviousness of independent claim 1. Therefore, we will sustain the rejection of independent claim 1 and dependent claims 2, 3, 5, 7, 9, 11, 12, and 17 grouped therewith by Appellants. Additionally, Appellants have elected to group independent claim 18 with independent claim 1. (App. Br. 6, 13 and Reply Br. 11, 20). Therefore, we group independent claim 18 and dependent claims 19, 20, 22-24, and 30 with independent claim 1.

Additionally, it is unclear in Appellants' asserted interpretation of "optimal print quality" whether each of the three new references cited in the Specification are required in a combination to achieve an "optimal print quality" or if each reference alone teaches how to achieve a separate "optimal print quality." Here, if we were to accept Appellants' asserted interpretation of "optimal print quality," we would be left to speculate as to what skilled artisans would glean from each reference to determine the metes and bounds of "optimal print quality." Therefore, without an express definition, we find it inappropriate for the Examiner to interpret "optimal print quality" as narrowly as Appellants advocate. Therefore, we agree with the Examiner that to interpret the claim language as Appellants advocate would be to read limitations into claim language and to speculate as to which limitations the skilled artisan would pick and choose from the three references.

Hence, we find that the Examiner has not been unreasonable in the interpretation of printer driver's to optimize the quality of prints for a specific printer. Clearly, the prior art teachings of the three incorporated references evidence that there are many facets to "optimal quality prints" for a specific printer and that there is not a singular optimum. If there were a single optimal quality, then Appellants should be capable of setting that forth in the language of independent claim 1. Here, Appellants have chosen to indirectly claim their "critical features" (App. Br. 9) of the claimed invention and have not presented a persuasive showing of error by the Examiner.

With respect to dependent claim 4, Appellants rely upon the same reasons discussed with respect to the three reference combination and further

contend that Fidler does not teach or suggest these "critical required features" including "producing the optimal quality print for a specific printer." (Reply Br. 22). Appellants argue that dependent claim 4 is directed to an interactive service which the user requested location based service from a service provider that needs the location of the mobile device to provide the user with the appropriate location based service. Appellants argue that the method of Fidler does not teach or even remotely suggest providing the interactive dialogue between the user and the service provider to obtain a location based service for the user and also to allow the user to make an optimal quality printed record for the service at the location of the mobile device. (Reply Br. 21).

First, we disagree with Appellants' contention that Fidler needs to teach or suggest providing an interactive dialogue between a user and the service provider to obtain location based service information for user. Here, the language of dependent claim 4 merely recites receiving at the receiving server data on the location of the mobile device, said data being generated by means for determining the location of the device. Second, Appellants argue a different portion of the reference than cited by the Examiner. Here, teachings of Fidler, as applied by the Examiner, teach and fairly suggest

> PDA's, portable personal computers, and the like may access via wireless communications resources such as printers. For example, a mobile user may wish to print an e-mail from his PDA, a photo from his digital camera, a map for directions to a selected location, or the like. The mobile user looking for local restaurants, for instance, may wish to download menus from restaurants to his PDA, and then print paper copies. To do so, the RTLS component determines the PDA location, then may query a network service via wireless technology to determine if a printer is close by.

(Fidler col. 2, ll. 15-25 and cited at Ans. 8).

Therefore, we do not find Appellants' argument commensurate in scope with the language of dependent claim 4, and Appellants do not rebut the portion of the Fidler reference relied upon by the Examiner. Therefore, Appellants have not shown error in the Examiner's initial showing of obviousness of dependent claim 4. Therefore, we will sustain the rejection of dependent claim 4 and dependent claims 8, 13-15, and 25-28 as grouped therewith by Appellants.

With respect to the Examiner's second combination of references applied against independent claim 1, Appellants contend that the claims are patently distinguishable for the same reasons discussed with respect to the first combination of references because the Cottrell patent does not disclose, teach or suggest critical required features of Appellants' claimed method and system including producing the optimal quality print for a specific printer. (Reply Br. 22). Appellants further contend that the Office in essence has taken one aspect of the teachings of Cottrell out of context of the overall teachings of the reference to support the rejection and the rejection relies upon only part of the disclosure and hence the Examiner has relied upon hindsight reconstruction. (Reply Br. 22-23).

Appellants' conclusory argument does not address the Examiner's combination of teachings and merely asserts that the teachings of Cottrell are out of context. Appellants' argument is unpersuasive of error in the Examiner's initial showing of obviousness of independent claim 1. Furthermore, as discussed above, we find the teachings of Cottrell concerning optimal quality print for a specific printer to be quite similar since they are the same as Appellants incorporate by reference in the

Specification. Therefore, we will sustain the rejection of independent claim 1 over the combination of Klear, Devarics, and Cottrell. We further sustain the rejection of independent claim 18 since Appellants have grouped this claim with independent claim 1.

With respect to dependent claim 4, Appellants set forth similar arguments as advanced above which we found unpersuasive of error in the Examiner's initial showing of obviousness of dependent claim 4. (App. Br. 17-19 and Reply Br. 23-25). Therefore, Appellants have not shown error in the Examiner's initial showing of obviousness of dependent claim 4. Therefore, we will sustain the rejection of dependent claim 4 and dependent claims 8, 13-15, and 25-28 as grouped therewith by Appellants.

V. CONCLUSION

For the aforementioned reasons, Appellants have not shown error in the Examiner's initial showing of obviousness and we concluded that it is inappropriate in this case to interpret/limit Appellants' claimed invention in light of the three references incorporated by reference in the Specification concerning "optimal quality print."

VI. ORDER

We affirm the obviousness rejections of claims 1-5, 7-9, 11-15, 17-20, 22-28, and 30.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

rwk

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891